PAIENT COOPERATION TREAT.

PCT

NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

Commissioner
US Department of Commerce
United States Patent and Trademark
Office, PCT
2011 South Clark Place Room
CP2/5C24
Arlington, VA 22202
ETATS-UNIS D'AMERIQUE

Date of mailing (day/month/year)
29 January 2001 (29.01.01)

in its capacity as elected Office

International application No.
PCT/GB00/02217

Applicant's or agent's file reference PBA/D88421PWO

International filing date (day/month/year)
19 June 2000 (19.06.00)

Priority date (day/month/year) 19 June 1999 (19.06.99)

Applicant

BARBER, Jill et al

1.	The designated Office is hereby notified of its election made:
	X in the demand filed with the International Preliminary Examining Authority on:
	08 December 2000 (08.12.00)
	in a notice effecting later election filed with the International Bureau on:
2.	The election X was
	was not
	made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Authorized officer

Olivia TEFY

Telephone No.: (41-22) 338.83.38

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

• •	or agent's file refere 8421PWO	FOR FURTHE	DAGTION	tification of Transmittal of International nary Examination Report (Form PCT/IPEA/416)
	al application No.	International filing	date (day/month/year)	Priority date (day/month/year)
	00/02217	19/06/2000		19/06/1999
International CO7H17/		on (IPC) or national classification a	nd IPC	
Applicant THE VIC	TORIA UNIVER	SITY OF MANCHESTER et	al.	
and is	s transmitted to the	e applicant according to Article	· 36.	nternational Preliminary Examining Authority
2. This I	REPORT consists	of a total of 9 sheets, includin	g this cover sheet.	
b (:	een amended and see Rule 70.16 an	accompanied by ANNEXES, i.ed are the basis for this report and Section 607 of the Administr	nd/or sheets containing	tion, claims and/or drawings which have rectifications made before this Authority r the PCT).
3. This i	eport contains ind	lications relating to the followin	g items:	
11	☐ Priority	·		
111	☑ Non-estable	ishment of opinion with regard	to novelty, inventive st	ep and industrial applicability
IV	Lack of unit	ty of invention		
V		statement under Article 35(2) v id explanations suporting such		nventive step or industrial applicability;
VI	☐ Certain do	cuments cited		
VII	☐ Certain def	ects in the international applica	ation	
VIII	☑ Certain obs	servations on the international	application	
Date of sub	mission of the dema	ınd	Date of completion	of this report
08/12/20		-	15.11.2001	
	mailing address of the examining authority European Patent C D-80298 Munich	: Office	Authorized officer Hornich, E	Super SCORES MICHIGAN
	Fax: +49 89 2399 -	0 Tx: 523656 epmu d	1	Red James Brees

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/GB00/02217

I.	Bas	is (of t	the	re	po	rt

1.	the and	receiving Office in I	response to an invitation under Article 14 are referred to in this report as "originally filed" this report since they do not contain amendments (Rules 70.16 and 70.17)):
	1-18	8	as originally filed
	Cla	ims, No.:	
	1-1	7	as originally filed
	Dra	wings, sheets:	
	1/24	1-24/24	as originally filed
2.		•	uage, all the elements marked above were available or furnished to this Authority in the nternational application was filed, unless otherwise indicated under this item.
	The	se elements were a	vailable or furnished to this Authority in the following language: , which is:
		the language of a t	ranslation furnished for the purposes of the international search (under Rule 23.1(b)).
		the language of pu	blication of the international application (under Rule 48.3(b)).
		the language of a t 55.2 and/or 55.3).	ranslation furnished for the purposes of international preliminary examination (under Rule
3.			leotide and/or amino acid sequence disclosed in the international application, the examination was carried out on the basis of the sequence listing:
		contained in the int	ernational application in written form.
		filed together with t	he international application in computer readable form.
		furnished subseque	ently to this Authority in written form.
		furnished subseque	ently to this Authority in computer readable form.
			the subsequently furnished written sequence listing does not go beyond the disclosure in plication as filed has been furnished.
		The statement that listing has been fur	the information recorded in computer readable form is identical to the written sequence nished.
4.	The	amendments have	resulted in the cancellation of:
		the description,	pages:
		the claims,	Nos.:



International application No. PCT/GB00/02217

		the drawings, sheets:
5.		This report has been established as if (some of) the amendments had not been made, since they have bee considered to go beyond the disclosure as filed (Rule 70.2(c)):
		(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)
6.	Adc	litional observations, if necessary:
III.	Nor	n-establishment of opinion with regard to novelty, inventive step and industrial applicability
1.		questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-ious), or to be industrially applicable have not been examined in respect of:
		the entire international application.
	×	claims Nos. 1-8, 14-17 partly (see Section III, 1.); 15, 17.
be	caus	se:
	×	the said international application, or the said claims Nos. 15, 17 (with regard to industrial applicability) relate to the following subject matter which does not require an international preliminary examination (<i>specify</i>): see separate sheet
		the description, claims or drawings (indicate particular elements below) or said claims Nos. are so unclear that no meaningful opinion could be formed (specify):
		the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
	×	no international search report has been established for the said claims Nos. 1-8, 14-17 (partly).
2.	and	eaningful international preliminary examination cannot be carried out due to the failure of the nucleotide /or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative ructions:
		the written form has not been furnished or does not comply with the standard.
		the computer readable form has not been furnished or does not comply with the standard.
٧.		asoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
1.		tions and explanations supporting such statement ement
	Nov	relty (N) Yes: Claims 1-9, 12, 17



International application No. PCT/GB00/02217

No: Claims 10, 11, 13-16

Inventive step (IS) Yes:

es: Claims

No: Claims 1-9, 12, 17

Industrial applicability (IA) Yes: Claims 1-14, 16

No: Claims

2. Citations and explanations see separate sheet

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made: see separate sheet

SECTION III

- The IPEA will only formulate an assessment of novelty, inventive step and industrial 1. applicability for the parts of the present claims for which an International Search Report has been drawn up (R. 66.1(e) PCT) (cf. form PCT/ISA/210, Box I), i.e. only for those parts relating to the compounds mentioned in claims 9, 10, 11 and 12 (Erythromycin B, 2'-esters of Erythromycin B, enol ethers of Erythromycin B; the compounds and in relation to microbial infection), i.e. for claims 1-8 and 14-17 partly (see also Section VIII).
- Claims 15 and 17 relate to subject-matter considered by this Authority to be covered 2. by the provisions of R. 67.1(iv) PCT. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Art. 34(4)(a)(i) PCT).

SECTION V

3. References:

- D1: MARTIN, YVONNE C. ET AL: 'Chemical modification of erythromycin antibiotics. 4. Structure-activity relations of erythromycin esters' J. MED. CHEM. (1972), 15(6), 635-8.
- D2: OMURA, SADAFUMI ET AL: 'Research and development of clarithromycin' YAKUGAKU ZASSHI (1992), 112(9), 593-614.
- D3: JONES, PETER H. ET AL: 'Chemical modifications of erythromycin antibiotics. 3. Synthesis of 4" and 11 esters of erythromycin A and B' J. MED. CHEM. (1972), 15(6), 631-4.
- D4: ONO, HIDEO ET AL: 'Drug resistance in Staphylococcus aureus. Induction of macrolide resistance by erythromycin, oleandomycin, and their derivatives' JPN. J. MICROBIOL. (1975), 19(5), 343-7.
- D5: BOJARSKA-DAHLIG, HALINA ET AL: 'Quantitative structure-activity relationships in erythromycin group with MTD technique' POL. J. PHARMACOL. PHARM. (1981), 33(3), 359-63.
- D6: KIBWAGE I O ET AL: 'ANTIBACTERIAL ACTIVITIES OF ERYTHROMYCINS

A B C AND D AND SOME OF THEIR DERIVATIVES' ANTIMICROBIAL AGENTS AND CHEMOTHERAPY, vol. 28, no. 5, 1985, pages 630-633, ISSN: 0066-4804.

D7: CANE, DAVID E. ET AL: 'Macrolide biosynthesis. 3. Stereochemistry of the chain-elongation steps of erythromycin biosynthesis' J. AM. CHEM. SOC. (1986), 108(16), 4957-64.

D8: EP-A-0 553 353

D9: MORDI, MOHD N. ET AL.: 'Acid-Catalyzed Degradation of Clarithromycin and Erythromycin B: A Comparative Study Using NMR Spectroscopy' J. MED. CHEM., vol. 43, no. 3, 2000, pages 467-474.

D10: BOJARSKA-DAHLIG, H.: 'Correlation of physicochemical parameters and antibacterial activity of macrocyclic antibiotics' ABH. AKAD. WISS. DDR, ABT. MATH., NATURWISS., TECH. (1978), (2N, QUANT. STRUCT.-ACT. ANAL.), 343-9.

D9 was published between the priority date and the filing date of the present application and has not been considered relevant prior art, as the examination has been carried out on the assumption that the priority has been validly claimed.

- 4. **Novelty** (Art. 33(2) PCT) with regard to item 1.
- D1 to D8 and D10 disclose Erythromycin B (e.g. D2, table II; D4), 2'-esters thereof (e.g. formyl-, acetyl-, propionyl-, benzoate (D7), ethyl succinate (D8, see further D1, D3, D10)) and Erythromycin B enol ether (D5, p. 363, l. 4/5) and report on the antimicrobial activity of the compounds.

Thus, as 2'-esters of Erythromycin B with mono- or dicarboxylic acids and Erythromycin B enol ether have already been disclosed, the subject-matter of claims 10, 11 and 13 cannot be regarded novel.

4.2 D6 discloses that commercially available samples of Erythromycin also comprise Erythromycin B and Erythromycin enol ether (Erythromycin B present up to 13%; 'the European Pharmacopoeia now has a limit of about 5% for these related substances; see p. 630, left col., paragraph 1; p. 632, right col., paragraph 3).

As (those commercially available samples of) Erythromycin is/are commonly used for the treatment of bacterial infections, Erythromycin B and the enol ether have implicitly been used in medical treatment (as comprised in the samples).

The 2'-esters of Erythromycin B (e.g. ethylsuccinate) disclosed within D8 show relieved bitterness compared to Erythromycin when orally administered (bacterial infections; ex. 10; p. 8, last paragraph).

Therefore, Erythromycin B, the enol ether and 2'-esters of Erythromycin B have already been used in the treatment of bacterial infections; thus, D8 and D10 anticipate the subject-matter of claims 14-16.

- 4.3 The subject-matter of claims 1-9, 12 and 17 appears to be novel, as neither the succinate of Erythromycin B nor compositions comprising at least 50% or particular amounts (as defined in claims 5 and 6) of Erythromycin B have been disclosed (with regard to item 1.).
- 5. Inventive Step (Art. 33(3) PCT) with regard to item 1.
- The object (problem to be solved in) of the present application is to provide alternative antibacterial agents to Erythromycin A, clarithromycin and azithromycin in order to obviate or mitigate the disadvantages associated with the abovementioned antibiotics (e.g. side effects due to degradation products).

The solution of the present application resides in the provision of Erythromycin B and 2'-esters of Erythromycin B or Erythromycin B enol ether and pharmaceutical compositions comprising the compounds in defined amounts (for the treatment of microbial infections).

Enythromycin B and other related compounds, e.g. the enol ether, are comprised in commercially available samples of Erythromycin (D6). The antimicrobial activity of Erythromycin B and derivatives (2'-esters) has been investigated and is known from D1 to D10 (see 'novelty'). Erythromycin B 2'-esters have already been used due to their alleviated bitterness and improved bioabsorbability (D8).

EXAMINATION REPORT - SEPARATE SHEET

The difference between the prior art and the present application appears to be the amount of Erythromycin B or derivative comprised in the composition, respectively the particular derivative succinate ester.

However, the application does not contain any data showing the effect of the particular amount of 'at least 50%' or the particular derivative 'succinate ester'.

Thus, as the claimed effect has not been evidenced, an inventive step could presently not be acknowledged for the subject-matter of claims 1-9, 12 and 17.

- Industrial Applicability (Art. 33(4) PCT) 6.
- The requirements of industrial applicability appear to be fulfilled for claims 1-13. 6.1
- 6.2 For the assessment of the present claims 14-17 on the question whether they are industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.

SECTION VIII

- 7. 'Derivative of Erythromycin B' (claims 1-6, 14-16 and also the dependent claims 7 and 17) does not refer to a well-defined group of compounds, thus leaving doubts about the components being encompassed by this definition.
 - Thus, the above-mentioned claims lack clarity in the sense of Art. 6 PCT.
- Concerning claim 10, it is not clear if Erythromycin B enol ether itself or 2'-esters of 8. Erythromycin B enol ether should be within the scope of protection (with regard to the subject-matter of claim 9) (Art. 6 PCT).
- 9. The category of claim 17 as referring to 'a use or a method' is not clear (Art. 6 PCT).



International application No. PCT/GB00/02217

EXAMINATION REPORT - SEPARATE SHEET



INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference PBA/D88421PW0	FOR FURTHER see Notification of (Form PCT/ISA/2	of Transmittal of International Search Report (20) as well as, where applicable, item 5 below.
International application No.	International filing date (day/month/year)	(Earliest) Priority Date (day/month/year)
PCT/GB 00/02217	19/06/2000	19/06/1999
Applicant		·
THE VICTORIA UNIVERSITY O	F MANCHESTER	
This International Search Report has bee according to Article 18. A copy is being tra	n prepared by this International Searching Aut ansmitted to the International Bureau.	hority and is transmitted to the applicant
This International Search Report consists It is also accompanied by	of a total of \$heets. a copy of each prior art document cited in this	s report.
1. Basis of the report		
a. With regard to the language, the language in which it was filed, un	international search was carried out on the balless otherwise indicated under this item.	isis of the international application in the
the international search w Authority (Rule 23.1(b)).	vas carried out on the basis of a translation of	the international application furnished to this
was carried out on the basis of th		nternational application, the international search
	ernational application in computer readable for	m.
I == -	o this Authority in written form.	
 	this Authority in computer readble form.	
the statement that the su	bsequently furnished written sequence listing as filed has been furnished.	does not go beyond the disclosure in the
1		is identical to the written sequence listing has been
2. Certain claims were fou	ind unsearchable (See Box I).	
3. Unity of invention is lac	cking (see Box II).	
4. With regard to the title ,		
	ubmitted by the applicant.	
the text has been established	shed by this Authority to read as follows:	
5. With regard to the abstract ,		
	ubmitted by the applicant.	
the text has been establi within one month from th	shed, according to Rule 38.2(b), by this Autho e date of mailing of this international search re	rity as it appears in Box III. The applicant may, eport, submit comments to this Authority.
6. The figure of the drawings to be put		TY Name of the Garage
as suggested by the app		X None of the figures.
because the applicant fa		
because this figure bette	r characterizes the invention.	

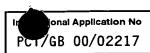
FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 210

Continuation of Box I.2

In view of the wording of claims 1-11,13-17 presently on file, in as far as the expression "Pharmaceutically acceptable derivative of Erythromycin B, enol ether of Erythromycin B" is concerned, which renders it difficult, if not impossible, to determine the matter for which protection is sought, the present application fails to comply with the clarity and conciseness requirements of Article 6 PCT (see also Rule 6.1(a) PCT) to such an extent that a meaningful search is impossible. Consequently, the search has been carried out for those parts of the application which do appear to be clear (and concise), namely the compositions/uses devices comprising Erythromycin B, 2'-esters of erythromycin, and internal enol ethers of Erythromycin B.

The applicant's attention is drawn to the fact that claims, or parts of claims, relating to inventions in respect of which no international search report has been established need not be the subject of an international preliminary examination (Rule 66.1(e) PCT). The applicant is advised that the EPO policy when acting as an International Preliminary Examining Authority is normally not to carry out a preliminary examination on matter which has not been searched. This is the case irrespective of whether or not the claims are amended following receipt of the search report or during any Chapter II procedure.





A. CLASSIFICATION OF SUBJECT MATTER IPC 7 A61P31/00 A61K31/7048 C07H17/08

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

 $\begin{array}{lll} \mbox{Minimum documentation searched} & \mbox{(classification system followed by classification symbols)} \\ \mbox{IPC 7} & \mbox{A61K} & \mbox{C07H} \\ \end{array}$

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

CHEM ABS Data, BIOSIS, EPO-Internal, EMBASE, WPI Data, MEDLINE

Category °	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
х	MARTIN, YVONNE C. ET AL: "Chemical modification of erythromycin antibiotics. 4. Structure-activity relations of erythromycin esters" J. MED. CHEM. (1972), 15(6), 635-8, XP001024313 the whole document	1-11, 13-17
x	OMURA, SADAFUMI ET AL: "Research and development of clarithromycin" YAKUGAKU ZASSHI (1992), 112(9), 593-614, XP002096748 abstract; tables 2,6	1-8, 14-17
	-/	

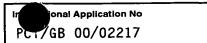
X Further documents are listed in the continuation of box C.	Patent family members are listed in annex.
 Special categories of cited documents: *A* document defining the general state of the art which is not considered to be of particular relevance *E* earlier document but published on or after the international filling date *L* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) *O* document referring to an oral disclosure, use, exhibition or other means *P* document published prior to the international filing date but later than the priority date claimed 	"T" tater document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art. "&" document member of the same patent family
Date of the actual completion of the international search	Date of mailing of the international search report
27 September 2001	12/10/2001
Name and mailing address of the ISA European Patent Office, P.B. 5818 Patentlaan 2 NL – 2280 HV Rijswijk Tel. (+31-70) 340-2040, Tx. 31 651 epo nl, Fax: (+31-70) 340-3016	Authorized officer A. Jakobs





	FC17 dB 007 02217		
	Relevant to claim No.		
Citation of document, with indication, whole appropriate, or the research			
JONES, PETER H. ET AL: "Chemical modifications of erythromycin antibiotics. 3. Synthesis of 4'' and 11 esters of erythromycin A and B" J. MED. CHEM. (1972), 15(6), 631-4, XP002178020 abstract page 633, column 2, paragraph 13 -page 634, column 1, paragraph 6	10,11		
ONO, HIDEO ET AL: "Drug resistance in Staphylococcus aureus. Induction of macrolide resistance by erythromycin, oleandomycin, and their derivatives" JPN. J. MICROBIOL. (1975), 19(5), 343-7, XP001028153 abstract; table 2	1-8, 14-17		
BOJARSKA-DAHLIG, HALINA ET AL: "Quantitative structure-activity relationships in erythromycin group with MTD technique" POL. J. PHARMACOL. PHARM. (1981), 33(3), 359-63, XP001028146 abstract page 359; table 1	1-8, 14-17		
KIBWAGE I O ET AL: "ANTIBACTERIAL ACTIVITIES OF ERYTHROMYCINS A B C AND D AND SOME OF THEIR DERIVATIVES" ANTIMICROBIAL AGENTS AND CHEMOTHERAPY, vol. 28, no. 5, 1985, pages 630-633, XP001028634 ISSN: 0066-4804 the whole document	1-8, 14-17		
CANE, DAVID E. ET AL: "Macrolide biosynthesis. 3. Stereochemistry of the chain-elongation steps of erythromycin biosynthesis" J. AM. CHEM. SOC. (1986), 108(16), 4957-64 XP002178022 abstract page 4959, column 2, paragraph 3	10,11		
EP 0 553 353 A (TAISHO PHARMA CO LTD) 4 August 1993 (1993-08-04) abstract; claims 1,2; example 10	10		
	modifications of erythromycin antibiotics. 3. Synthesis of 4'' and 11 esters of erythromycin A and B" J. MED. CHEM. (1972), 15(6), 631-4, XP002178020 abstract page 633, column 2, paragraph 13 -page 634, column 1, paragraph 6 ONO, HIDEO ET AL: "Drug resistance in Staphylococcus aureus. Induction of macrolide resistance by erythromycin, oleandomycin, and their derivatives" JPN. J. MICROBIOL. (1975), 19(5), 343-7, XP001028153 abstract; table 2 BOJARSKA-DAHLIG, HALINA ET AL: "Quantitative structure-activity relationships in erythromycin group with MTD technique" POL. J. PHARMACOL. PHARM. (1981), 33(3), 359-63, XP001028146 abstract page 359; table 1 KIBWAGE I O ET AL: "ANTIBACTERIAL ACTIVITIES OF ERYTHROMYCINS A B C AND D AND SOME OF THEIR DERIVATIVES" ANTIMICROBIAL AGENTS AND CHEMOTHERAPY, vol. 28, no. 5, 1985, pages 630-633, XP001028634 ISSN: 0066-4804 the whole document CANE, DAVID E. ET AL: "Macrolide biosynthesis. 3. Stereochemistry of the chain-elongation steps of erythromycin biosynthesis." J. AM. CHEM. SOC. (1986), 108(16), 4957-64 'XP002178022 abstract page 4959, column 2, paragraph 3 EP 0 553 353 A (TAISHO PHARMA CO LTD) 4 August 1993 (1993-08-04) abstract; claims 1,2; example 10		





FC1/4B 00/02217		
Relevant to claim No.		
Relevant to claim No.		
1-17		
1-8, 14-17		
1-8, 14-17		
1-8, 14-17		



T ₄	ional Application N	lo
1	Pc1/GB 00/02217	7

Patent document cited in search report		Publication date		Patent family member(s)	Publication date
EP 0553353	A	04-08-1993	EP WO US	0553353 A1 9206991 A1 5350839 A	04-08-1993 30-04-1992 27-09-1994
WO 9833482	Α	06-08-1998	AU EP WO ZA	6041498 A 0975330 A1 9833482 A1 9800833 A	25-08-1998 02-02-2000 06-08-1998 26-05-1999